



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,541	03/31/2004	William D. Goldberg	RSW920040016US1	7408

43168 7590 01/07/2010
MARCIA L. DOUBET LAW FIRM
PO BOX 422859
KISSIMMEE, FL 34742

EXAMINER

ANDERSON, FOLASHADE

ART UNIT	PAPER NUMBER
----------	--------------

3623

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

01/07/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mld@mindspring.com

Office Action Summary	Application No. 10/814,541	Applicant(s) GOLDBERG ET AL.	
	Examiner FOLASHADE ANDERSON	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-21, 28 and 32-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-21, 28 and 32-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This non-final office action is in response to Applicant's submission filed on 10/02/2009. Currently, claims 18-21, 28, and 32-38 are pending. Claims 32-38 are newly added. Claims 1-17 and 22-27 were previously canceled.
2. Included with this office action is a copy of the previously cited, but not mailed non-patent literature of: L. Willcocks, M. Lacity, and G. Fitzgerald (1995) Information technology outsourcing in Europe and the USA: Assessment issues International Journal of Information Management Volume 15, Issue 5, October 1995, Pages 333-351

Response to Amendment

3. Applicant's amendments to claim 18 are sufficient to overcome the 35 USC § 101 rejection set forth in the previous office action.

Response to Arguments

4. Applicant argues the following:
 - a. A prima facie case has not been presented with respect to the limitations "programmatically computing a value..." and "assigning the determined resources..." of **claim 18**. See remarks page 10
 - b. Prior art teachings of Keay are silent on "programmatically selecting a location" with respect to **claim 28**. See remarks page 10.

Art Unit: 3623

5. Applicant's arguments 4.a. have been fully considered but they are not persuasive.

While Examiner agrees the teachings of Srinivasan were not particularly pointed out it does not negate that Srinivasan fully teaches the previous present **claim 18**.

Specifically Srinivasan teaches:

- programmatically computing a value using the business objectives, according to the developed objective measurements, and the developed cost factors, and using the programmatically-computed value to programmatically select a particular location from among the candidate locations (col.6, lines 17-49); and
- assigning the determined resources to the programmatically-selected particular location (table 1.4 at cols. 29-32 and col. 33, lines 1-53).

6. Applicant's arguments 4.b. with respect to the rejection(s) of **claim 28** under 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Srinivasan et al (US 6,895,382).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. **Claims 32-35 and 37-38** rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

Art Unit: 3623

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For example **claim 32** recites:

- computing a gap value for each of the business objectives in each of the candidate locations by subtracting the location-specific score for the business objective from the importance value for the business objective; and
- for each of the candidate locations, using the computed gap value for each of the business objectives in the candidate location, and the developed cost factors, to yield a cost of placing the resource in the candidate location.

Specifically Applicant has not provided support for the gap value for each of the business objectives. It is noted that **claims 34 and 37** recites similar unsupported claim language. **Claims 33, 35 and 38** are rejected as dependents of claims 32, 34, and 37 respectively which suffer similar deficiencies as those given above.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. **Claims 18 and 28** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites the phrase “suitable for assessing;” however, no guidance is give for what is encompassed in “suitable”. For purposes of examination “suitable” is interpreted to mean any object the use

Art Unit: 3623

deems necessary. Support for this interpretation may be found in the instant specification at least at page 15, lines 1-5.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 18, 20, 21, and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Srinivasan et al (US Patent 6,895,382 B1).

Claim 18 Srinivasan teaches a method of determining resource placement (abstract), comprising:

- determining a set of business objectives suitable for assessing each of a plurality of candidate locations for resource placement (Srinivasan col. 2, lines 15-24, col. 11, lines 29-48 and table 2, col. 11 and 12);
- developing one or more objective measurements for each business objective (Srinivasan col. 6, lines 17-48)

Art Unit: 3623

- performing value chain analyses related to the set of business objectives, thereby determining what resources will potentially improve the analyzed value chain (Srinivasan tables 1-3);
- developing cost factors for cost of placing the determined resources in the candidate locations (Srinivasan chart 1.3 rates, col. 26 and chart 1.4 staff transition matrix, col. 29-32 showing the delta of current cost, in-house cost and outsourced cost) ;
- using computer-readable program code executed by a computer to programmatically compute a value for each of the candidate locations using the business objectives, according to the developed objective measurements, and the developed cost factors (Srinivasan col. 2, lines 33-37 and col.6, lines 17- 33),
- using computer-readable program code executed by the computer to programmatically select a particular location from among the candidate locations, based on the programmatically-computed values (Srinivasan col.6, lines 17-49); and
- assigning the determined resources to the programmatically-selected particular location (Srinivasan table 1.4 at cols. 29-32 and col. 33, lines 1-53).

Claim 20 Srinivasan teaches the method according to Claim 18, wherein the assigned resources are information technology personnel (Srinivasan col. 26, lines 1-5).

Art Unit: 3623

Claim 21 Srinivasan teaches the method according to Claim 18, wherein the assigned resources comprise monetary investments in the particular location (Srinivasan skills rate table col. 26, lines 30-67).

Claim 36 Srinivasan teaches a computer program product for determining resource placement, the computer program product embodied on one or more computer-usable storage media and comprising computer-usable program code for:

- programmatically computing a value for each of a plurality of candidate locations using a set of business objectives suitable for assessing each of the plurality of candidate locations for resource placement (Srinivasan col. 2, lines 15-24, col. 11, lines 29-48 and table 2, col. 11 and 12), according to one or more objective measurements developed for each business objective, and cost factors developed for costs of placing resources in the candidate locations, the resources determined by performing value chain analyses related to the set of business objectives to identify what resources will potentially improve the analyzed value chain (Srinivasan col.1, lines 10-21 and col. 6, lines 17-33); and
- programmatically selecting a particular location from among the candidate locations, based on the programmatically-computed values, for assigning the determined resources (Srinivasan col. 1, lines 10-21 and col. 6, lines 34-49).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan et al (US Patent 6,895,382) in view of Baker et al (Project Management, 2nd Edition, published 2000).

Claim 19 Srinivasan teaches the method according to Claim 18; and wherein programmatically computing the value for each of the candidate locations (Srinivasan col. 2, lines 33-37 and col.6, lines 17- 33); however Srinivasan is silent on, further comprises estimating and accounting for any lag time characteristics discovered while performing the value chain analyses.

Baker teaches wherein the computing further comprises estimating and accounting for any lag time characteristics discovered while performing the value chain analyses (Baker p.113).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Srinivasan the estimating and accounting for any lag time characteristics discovered while performing the value chain analyses as taught by Baker since the claimed invention is merely a combination of old elements, and in

Art Unit: 3623

the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

15. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keay et al (US Publication 2005/0065831 A1) in view of Srinivasan et al (US Patent 6,895,382)

Claim 28 Keay teaches a system for assigning resources, comprising:

- a computer comprising a processor (Keay 0002, 0041);
- a set of business objectives suitable for assessing each of a plurality of one or more candidate locations for resource placement (Keay 0016);
- one or more objective measurements for each business objective (Keay 0093, 0100);
- results of value chain analyses performed related to the set of business objectives, the results usable for determining what resources will potentially improve the analyzed value chain (Keay figures 4A & 4B and 0095-0100);
- cost factors for costs of placing the determined resources in the candidate locations (Keay 0043, 0058);
- instructions which are executable on the computer, using the processor, to implement functions comprising (Keay 0105):

- programmatically computing a value for each of the candidate locations using the business objectives, according to the developed objective measurements, and the developed cost factors (Keay 0093, 0100); and
- using the programmatically-computed value to (Keay 0043, 0058);.

Keay further teaches business simulations (Keay 0043) selection of business process to be performed (Keay 0058); however Keay does not teach the limitation of programmatically select a particular location from among the candidate locations, based on the programmatically-computed values, thereby enabling assignment of the determined resources for placement in the programmatically-selected particular location.

Srinivasan does teach programmatically select a particular location from among the candidate locations, based on the programmatically-computed values, thereby enabling assignment of the determined resources for placement in the programmatically-selected particular location (Srinivasan col.6, lines 17-49)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Keay programmatically select a particular location from among the candidate locations, based on the programmatically-computed values, thereby enabling assignment of the determined resources for placement in the programmatically-selected particular location as taught by Srinivasan since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of

Art Unit: 3623

ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FOLASHADE ANDERSON whose telephone number is (571)270-3331. The examiner can normally be reached on Monday through Thursday 8:00 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 3623

If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Folashade Anderson/
Examiner, Art Unit 3623

/Andre Boyce/
Primary Examiner, Art Unit 3623